

REMARKSThe Claims

Claims 61-75 are currently pending in the application and are directed to antibodies which bind specifically to SEQ ID NO:121, 123 or 125, which amino acid sequences correspond to rat, mouse or human OPG, respectively.

Claims 61, 63 and 65 have been amended to place the claims in condition for allowance or appeal. The amendments do not introduce new matter or raise new issues requiring further consideration and/or search and entry of same is requested.

Rejections under 35 U.S.C. 112

Claims 61, 63, 65 and 69-75 are rejected under 35 U.S.C. 112, first paragraph. The Examiner argues that the claims do not specify that the recited epitope is an epitope of SEQ ID NO:121 and therefore encompass antibodies which are not specific for SEQ ID NO:121 (i.e, non-specific antibodies). Based on this, the Examiner alleges that the claims are not enabled as it would require undue experimentation to use such non-specific antibodies. As Claims 63 and 65 are directed to SEQ ID NO:123 and 125, respectively, rather than SEQ ID NO:121, it is assumed that the rejection applies to antibodies binding to at least a portion of those sequences as well.

Applicants maintain that the Examiner is incorrect in the statement that the claimed antibodies would encompass antibodies lacking any specificity for SEQ ID NO:121. The claims recite antibodies which specifically bind an epitope comprising at least a portion of SEQ ID NO:121, that is, the specificity of antibody binding resides at least in part on the presence of some portion of SEQ ID NO:121. Clearly, such antibodies may be used similarly to those which bind to epitopes wholly defined by some part of SEQ ID NO:121 and no undue experimentation would result in using any of the claimed antibodies.

Moreover, it would have been well within the capabilities of one skilled in the art to screen for antibodies which specifically bind an epitope comprising at least a portion of SEQ ID NO:121. Screening for antibodies having certain desired properties is not considered to involve undue experimentation. *In re Wands* 8 USPQ2d 1406 (Fed. Cir. 1988). One can also define an epitope bound by an antibody using a variety of techniques available to the skilled worker, enabling one to identify those residues within SEQ ID NO:121 which comprise the epitope.

The arguments presented herein would also apply to those antibodies which specifically bind an epitope comprising at least a portion of SEQ ID NO:123 or SEQ ID NO:125.

Without acquiescing to the rejection and solely to advance prosecution, Applicants have amended Claims 61, 63 and 65.

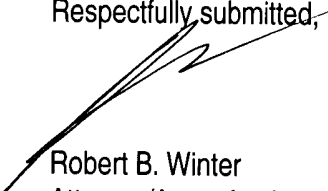
Claim objections

Claims 62, 64 and 66-68 are objected to for depending upon a rejected base claim. It is believed that the base claims are in condition for allowance, thereby rendering the objection moot.

CONCLUSION

Claims 61-75 are in condition for allowance and an early notice thereof is solicited.

Respectfully submitted,


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